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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,335	07/21/2005	Anwa Khan	37319	2580
116 7590 07/09/2008 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108				
EXAMINER				
OSANU, FELIX C				
ART UNIT		PAPER NUMBER		
3635				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary

Application No.

10/520,335

Applicant(s)

KHAN, ANWA

Examiner

FELIX OSANU

Art Unit

3635

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 19, 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date January 5, 2005
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant has amended claim1 in the response dated 5/19/2008. A new office action necessitated by applicant's amendment is found below.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New matter "acoustic member" is not properly supported in the disclosure or drawings of the application.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 & 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott (U.S. 5022211) in view of MacKinnon, Jr. et al (U.S. 4471592).

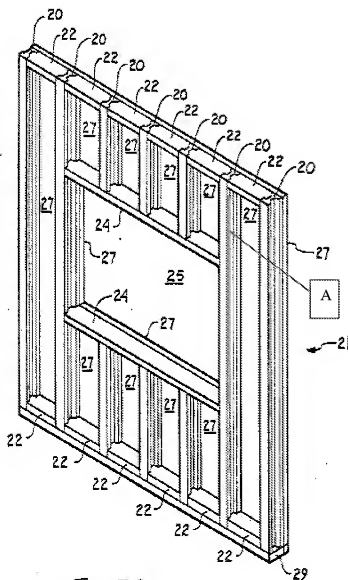
Regarding claim 1, Scott teaches spaced apart plurality of composite wall studs for a wall structure comprising a central stud member (20) having opposed faces and a recess (A, fig. 24 annotated below) in each face, insulating member with acoustic properties (column 12 line 4) outer stud members (20) and rigid sheet of covering (acoustic support member) affixed to one or each side of the frame (27, 84, 104). See figures 7, 24, 26 & 28 and column 7, line 53-58 & column 10, lines 65-68 & column 11, lines 11, 42-44, 68). Scott does not teach acoustic support member seated in the recess formed in the face of the central stud. However, MacKinnon, Jr. et al teaches spaced apart plurality of wall studs (18, 20) for a wall structure, an acoustic support member (12) mounted on each face of the stud members, acoustic member (36) being seated in and substantially filling the recess formed in the face of the stud members (20) and an outer stud member on the outer side of said acoustic member and held captive thereby (fig. 2 & 3). It would have been obvious and well within the level of ordinary skills in the art at the time of invention was made to substantially fill the recess formed in the face of the stud in order to secure the acoustic member to the recesses of the stud members.

Regarding claim 4, Scott teaches plurality of spaced apart wall studs for a wall structure comprising wall sheeting (104) connecting each side of the adjacent wall studs and insulating material between the wall sheeting (figure 28 & column 12, lines 1-8).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scott (U.S.5022211) in view of MacKinnon, Jr. et al (U.S. 4471592) and, further in view of

Masui et al (U.S. 5968629). Scott and MacKinnon, Jr. et al teaches elements as described in claim 1 rejection above but neither teaches acoustic member having outwardly spaced apart arms. However, Masui et al discloses a thermoplastic acoustic material formed in shape suitable for each application having an inner face and outwardly facing spaced apart arms (fig. 1, 7 & column 5 lines 18-21). It would have been obvious and well within the level of ordinary skills in the art at the time of invention was made to comprise an acoustic member having a portion with an inner face and outwardly extending spaced apart arms in order to terminate the said arms in inwardly directed flanges that define recesses as taught Scott or MacKinnon, Jr. et al.

6. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Scott (U.S.5022211) in view of MacKinnon, Jr. et al (U.S. 4471592) and Masui et al (U.S. 5968629) and further in view of McCavour (U.S. 5833394). Scott, Masui et al and MacKinnon, Jr. et al teach elements as described in claims 1 & 2 rejection above but neither teaches outer stud members having enlarged head. However, McCavour teaches stud member (96) having an enlarged head (108). See figure 6 & column 9, lines 20-21. It would have been obvious and well within the level of ordinary skills in the art at the time of invention was made to substitute the outer stud member as taught by either Scott or MacKinnon, Jr. et al for stud members with enlarged head of McCavour in order to secure fit the outer stud members within the flanges of the acoustic support member.



Response to Arguments

7. Applicant's arguments filed 5/19/2008 have been fully considered but they are not persuasive. Applicant's arguments regarding amended claims are moot as the amendment of 5/19/2008 necessitated a new rejection.

Applicant has amended claims 1 & 2 to include acoustic member wherein the acoustic member substantially fills the recess in the central stud. Combination of prior art of Scott, MacKinnon, Jr. et al and Masui et al meet the limitations of the amended claims. Applicant also argued that prior art cited by Examiner does not support an acoustic member mounted on the recessed face of the central stud. However, applicant's attention is referred to figure 24 (annotated) enclosed with this office action. Fig 24 (annotated) clearly shows the recessed face (A) in each face of the stud members. The request by Applicant that application be examined on claims submitted with 371 application dated January 5, 2005 was complied with in Examiner's prior office action dated January 22, 2008.

In a telephonic interview with the applicant on June 37 2008, applicant stated that acoustic member is same element as acoustic support member. Applicant also confirmed that the disclosure does not provide a support for an acoustic member. Applicant's argument are not persuasive.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix Osanu whose telephone number is 571-270-3659. The examiner can normally be reached on M-TH & alt. F (8AM - 5PM) EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3635

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Felix Osanu
Examiner
Art Unit 3635

/Richard E. Chilcot/
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F. O.